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10/630,069	07/30/2003	Tazwell L. Anderson JR.	20973-20	9455

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EXAMINER

VU, NGOC K

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/630,069	Applicant(s) ANDERSON ET AL.	
	Examiner Ngoc K. Vu	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/24/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 112 for claims 1-25 of this application. In particular, applicant claims priority to application 09/837,128 as a continuation-in-part, which further claims priority to application 09/386,613 as a continuation-in-part, and further claims priority to application 09/322,411 as a continuation-in-part. However, the disclosures of applications 09/837128, 09/836613, and 09/322411 fail to disclose the subject matter claimed by applicants in the instant application. Specifically, the disclosures of these applications fail to disclose a portable device comprising storing event content in a memory, downloading the stored event content to an external device, controlling operation in a plurality of modes as presently claimed in the instant application. Accordingly, applicants are denied the benefit of the 04/18/2001 filing date of CIP of application 09/837128, the 08/31/1999 filing date of CIP of application 09386613, and the 05/28/1999 of CIP of application 09/322411.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (22 November 2005) Annex IV stated "a signal does not fall within one of the four statutory classes of § 101."

3. Claim 25 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows.

Claim 25 is directed to an image which is considered a signal. Further, this claim could

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also be considered non-functional descriptive material that is not embodied on a tangible computer readable medium.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 25 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Particularly, the original specification does not describe “image comprising one of one or more video signals transmitted at the event and captured images at the event” as claimed. Instead, the specification describes that the system receives video and audio signals for use in displaying images of an event (see 0010, 0021, 0022). This clearly indicates that the video signal comprises image(s). Therefore, this feature directly contradicts what is claimed.

6. Claim 25 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Particularly, the feature of “image comprising one of one or more video signals transmitted at the event and captured images at the event” is not disclosed in the specification.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 5 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 is indefinite because there is no antecedent basis for the limitation "the display" in line 2.

Claim 20 is indefinite because there is no antecedent basis for the limitation "the display" in line 1.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 5, 8, 14, 15 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Sibley (U.S. 20010039663 A1).

Regarding claim 1, Sibley discloses a portable device (i.e., user device 18, wherein the user device may be a laptop computer or a hand-held device – see figures 1 & 3, 0038), comprising: a receiver (90) for receiving video signals relating to an event (i.e., electronic content includes television programming) (0044 and figure 3); a viewing system (16, 78) configured to provide event content for viewing based upon at least one of the video signals

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selected by a user (the system provides the requested certain electronic content to subscriber) (0038, 0039, 0042, 0044, 0046); and a memory component (94) configured to store event content (0039, 0045, 0049).

Regarding claim 5, Sibley discloses that wherein the memory component is configured for access to view the stored event content on the display (for instance, for each item stored in memory 94, a menu item is displayed on display 96 so that the user may select the electronic content when desired - see 0044, 0046).

Regarding claim 8, Sibley discloses a processor (within the user device 18) for controlling operation in a plurality of modes (since the user devices has cellular phone and television functions – see 0052).

Regarding claims 14 and 15, Sibley discloses that a power source 141 may be a battery or a rechargeable battery (see 0056).

Regarding claim 25, Sibley discloses an image of an event (from electronic content – see 0033) configured for display on a portable device (user device 18 – see figures 1 & 3, 0038), the image comprising one or more video signals transmitted at the event (the electronic content may be television programming), the video signals selectable by a user for display and provided using one of a plurality of modes of operation, the plurality of modes of operation including video or television viewer (see 0042, 0044, 0047).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sibley (U.S. 20010039663 A1).

Regarding claims 6 and 7, Sibley discloses storing the content in the memory 94 of user device (see 0039, 0044-0046). Sibley does not explicitly disclose downloading the content to an external device, and/or wherein the memory component is configured for removable connection to the portable device. Official Notice is taken that downloading or transferring data to a removable device such as flash memory for storing data is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Sibley by downloading content to ^{an} external device such as flash memory in order to provide a quickest and easiest way to transfer large data for storing the data in the flash memory.

13. Claims 2-4, 9, 10, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sibley (U.S. 20010039663 A1) in view of Koehler et al. (U.S. 20010042105 A1).

Regarding claims 2 and 3, Sibley discloses wherein the receiver is configured to receive electronic content comprising video/audio signals relating to the event (i.e., television programming) (see 0033). Sibley does not disclose the receiver further comprising an audio component configured to provide event content for listening based upon at least one of the audio signals selected by a user and wherein the video and audio signals are transmitted for reception only at the event. However, Koehler disclose providing audio signals from a plurality of audio sources at the race event such that user can select any or all of the team or the participants to listen to during the race. The system further provides video information or a plurality of car views during the race so that the user can select one or more views from the car views (see 0016, 0018, 0024, 0027). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Sibley by providing an

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audio content for listening based upon at least one of audio signals selected by a user and wherein the video and audio signals are transmitted for reception at a race event as disclosed by Koehler in order to allow user to selectively listen to communications of race team participating and/or view car views in a race event.

Regarding claim 4, Sibley teaches that the video and audio signals further comprise non-event related content (music videos, advertising and promotional materials – see 0033).

Regarding claim 9, Sibley teaches the device comprising a processor (within the user device 18) for controlling operation in a plurality of modes, wherein the plurality of modes comprises at least one of video or television viewer (see 0052).

Regarding claim 10, Sibley teaches the device comprising a housing having a user input (98) for selecting one of a plurality of the modes of operation, wherein the plurality of modes comprises at least one of video or television viewer (see 0042, 0044, 0047)

Regarding claim 16, Sibley teaches that wherein the receiver is configured to receive the video and audio signals on a plurality of frequencies (the electronic content may be television programming that includes wide variety of multi-channel content – see 0033).

Regarding claim 17, Sibley teaches that wherein the receiver is configured to receive the video and audio signals using a plurality of transmission protocols (cable, satellite, cellular communication system – see 0034, 0037 and figure 2).

Regarding claim 18, Sibley teaches that wherein the receiver is configured to receive the video and audio signals only when authorized (see 0052).

Regarding claim 19, Sibley teaches wherein the receiver is configured to receive the video and audio signals only when authorized, the authorization based upon a unique code associated with a portable device (conditional access software – see 0052).

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14. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sibley (U.S. 20010039663 A1) in view of Matsui et al. (US 6,052,239 A).

Regarding claims 11-13, Sibley does not teach the portable device further comprising an optics system having first and second lens assemblies provided as part of a housing, the optics system configured to provide a plurality of magnified modes of operation. However, Matsui teaches a magnification optical system comprising a pair of lens that are accommodated in a housing of a portable device. A user can operates operation button to cause the magnification optical system to set the distance and the size of the virtual image. The distance to an virtual image or the like is changed in accordance with an image. The distance can also be changed by operating the option button (see figure 2; col. 1, lines 6-11; col. 1-2, lines 66-8; col. 4, lines 46-58; col. 16, lines 50-53). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Sibley by including optics system having first and second lens assemblies provided as part of a housing, the optics system configured to provide a plurality of magnified modes of operation as taught by Matsui in order to effectively provide user a magnified information for better viewing.

15. Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sibley (U.S. 20010039663 A1) in view of Koehler et al. (U.S. 20010042105 A1) in view of Matsui et al. (US 6,052,239 A).

Regarding claim 21, Sibley discloses a portable event entertainment device (user device 18, wherein the user device may be a laptop computer or a hand-held device – see figures 1 & 3, 0038), comprising: a receiver (90) for receiving video signals relating to an event (i.e., electronic content includes television programming) (0044 and figure 3); a display (96) configured to allow viewing the images of the event based upon at least one received video signal selected by a user (the system provides the requested certain electronic content to

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subscriber - 0038, 0039, 0042, 0044, 0046); an audio system (within the user device – see figures 1 and 6-7) configured to allow listening to the sounds of the event; a processor (within the user device) for controlling operation in a plurality of modes, wherein the plurality of modes comprises at least one of video or television viewer (see 0052); and a memory component configured to store images and sounds of the event (see 0039, 0045, 0049).

Sibley does not teach the video and audio signals defining images and sounds of the event and transmitted for reception at the event and providing sounds of the event based upon at least one received audio signal selected by a user. However, Koehler disclose providing audio signals from a plurality of audio sources at the race event such that user can select any or all of the team or the participants to listen to during the race. The system further provides video information or a plurality of car views during the race so that the user can select one or more views from the car views (see 0016, 0018, 0024, 0027). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Sibley by providing an audio content for listening based upon at least one of audio signals selected by a user and wherein the video and audio signals are transmitted for reception at a race event as disclosed by Koehler in order to allow user to selectively listen to communications of race team participating and/or view car views in a race event.

Further regarding claim 21 and claim 24, Sibley does not teach an optics system configured to allow viewing of the event and the optics system configured to provide a plurality of magnified modes of operation. However, Matsui teaches a magnification optical system comprising a pair of lens that are accommodated in a housing of a portable device. A user can operates operation button to cause the magnification optical system to set the distance and the size of the virtual image. The distance to an virtual image or the like is changed in accordance with an image. The distance can also be changed by operating the option button (see figure 2;

col. 1, lines 6-11; col. 1-2, lines 66-8; col. 4, lines 46-58; col. 16, lines 50-53). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Sibley by including optics system having first and second lens assemblies provided as part of a housing, the optics system configured to provide a plurality of magnified modes of operation as taught by Matsui in order to effectively provide user a magnified information for better viewing.

Regarding claim 22, Sibley discloses providing conditional access to the event content based upon a unique access code (conditional access software – see 0052).

Regarding claim 23, Sibley discloses a user input (98) selectably operable by a user to control the images and sounds provided to the display and audio system (see 0044, 0047).

16. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sibley (U.S. 20010039663 A1) in view of Rallison et al. (U.S. 5,903,395 A).

Regarding claim 20, Sibley fails to disclose that the display is configured for viewing by a user when engaged with the user's face. However, Rallison discloses a personal visual display including a head-mounted display for providing a high quality of image and an exclusive view of the visual information (see abstract; col.1, lines 3-6 and 60-63 and figures 1 and 15). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Sibley by including the a personal visual display including a head-mounted display as taught by Rallison in order to provide a high quality of image and an exclusive view of the visual information.

Conclusion

17. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an

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individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 571-272-7306. The examiner can normally be reached on Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ngoc K. Vu
Primary Examiner
Art Unit 2623

August 18, 2006